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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/295,864	04/21/1999	ADAM M. FELDSTEIN	MCS-003-98	7677
27662	7590	07/27/2005	EXAMINER	
LYON & HARR, LLP 300 ESPLANADE DRIVE, SUITE 800 OXNARD, CA 93036			CHAMPAGNE, DONALD	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/295,864

Applicant(s)

FELDSTEIN ET AL.

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 April 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 25 March 2005 has been entered.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not disclose "preventing the user from encountering sub-item or dependency conflicts by automatically correcting any conflicts". The spec. discloses conflicts only once, at p. 14 lines 15-19, where it is disclosed that the control module dynamically prevents data value conflicts. Nowhere is it disclosed how said conflicts are prevented:

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. "sub-item or dependency conflicts" is indefinite. The spec. discloses conflicts only once, as "data value conflicts", at p. 14 lines 18-19. Neither there nor

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elsewhere in the spec. is it disclosed what about the data values or sub-items or dependencies is in conflict.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-9, 12-22, 25-28, 30 and 32 are rejected under 35 USC 103(a) as obvious over Bull et al. in view of Gifford.
8. Bull et al. teaches (independent claims 1, 12 and 25) a computer-implemented method for displaying personalized information on a client system, a display device for rendering said information thereon, and a computer-readable medium containing the method, the method comprising: collecting data associated with a user ((col. 3 lines 36-37); processing the data to create unique user profiles (col. 31 lines 37-42); tracking at least a portion of the data and providing the user with a variety of search options (col. 3 line 63 to col. 4 line 6), which reads on performing estimation calculations to generate results and updated personal information using the client; and automatically communicating the results and the personalized and updated information to the user via the client (col. 3 lines 55-57). Bull et al. also teaches (independent claim 32) categorizing at least a portion of the query (the user's activity) as trackable data (col. 3 lines 34-35).
9. Bull et al. also teaches targeted advertising (col. 4 line 62 to col. 5 line 9, col. 8 line 47, and col. 13 lines 33-36), which means preventing the user from encountering advertising results that are not pertinent to the user, which reads on preventing the user from encountering sub-item conflicts, where the ad is a sub-item of the search, by automatically preventing any conflicts. The reference gives as an example (col. 5 lines 7-9) automatically presenting ads for Hilton Inns on the West Coast when the use has expressed an interest in Holiday Inns on the West Coast. The reference invention has prevented the user from being presented with (encountering) Hilton Inns on the East Coast, which would have been a sub-item conflict.

10. Interpretation of "sub-item conflicts" Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...".
11. The instant application contains no such clear definition for the phrase "sub-item conflicts". The specification does disclose by its use of the terms that a "sub-item" is a subset of a set of search results and can be the result of a "sub-request", which means a subsequent request in the search (pp. 14, 15, 22 and 23). Hence the reference's teaching of an ad or coupon reads on a sub-item. As to "conflicts" of said sub-item(s), there is little guidance in the spec. as to what applicant means. The examiner is required to give the term "sub-item conflicts" its broadest reasonable interpretation, which the examiner judges to be any incompatibility or inconsistency between the presented sub-item ad and what the user would want in said sub-item ad (Merriam Webster's Collegiate Dictionary meaning 2a for "conflict"). This is illustrated at the end of para. 9 above, where ads dealing with Hilton Inns on the East Coast would constitute a sub-item conflict because the user has expressed interest only in lodging on the West Coast.
12. Bull et al. does not teach adjusting the results dynamically on the client. Gifford teaches adjusting the results dynamically on the client (col. 10 lines 35-48). Gifford teaches that this permits the user's most frequent requests to be answered from the local terminal (client, col. 10 lines 39-41). Because this would be understood by one of ordinary skill in the art to eliminate delays in communicating with the server, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Gifford to those of Bull et al.
13. Neither Bull et al. nor Gifford teach adjusting the results dynamically on the client by a user's interaction with the results. However, Gifford does teach that a user can compile, and

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therefore update, a list of queries (col. 10 lines 41-43). It is obvious for a user to update the list of queries in response to finding deficiencies in the results, which reads on interacting with the results. Hence, in view Gifford, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to adjust the results dynamically on the client by a user's interaction with the results.

14. Bull et al. also teaches: (claims 2 and 13) an interactive computer environment (col. 4 line 15); (claims 3, 4, 16, 17 and 26) with communication over the WWW in HTML (col. 3 lines 58 and 52); (claims 5, 6, 14, 15, 18, 19 and 27) providing interactive graphical control interface options (col. 3 line 61 and col. 4 line 15); (claims 7 and 20) user characteristics including the user profiles (col. 4 lines 20-23); (claims 8 and 21) transmission of results by personalized e-mail (col. 4 line 12); (claims 9, 22 and 28) allowing real-time interaction with the information (col. 4 line 15); and (claim 30) using the classification profile to demographically and statistically perform target marketing (col. 14 lines 19-25).
15. Claims 10, 11, 23, 24 and 29 are rejected under 35 USC 103(a) as obvious over the references cited above and further in view of Wong.
16. Neither Bull et al. nor Gifford teaches calculating projected automobile repair costs. Wong teaches calculating projected automobile costs. Because the combination would be very helpful to user's negotiating damage settlements with their auto insurance companies, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to combine the teachings of Wong with those of Bull et al. and Gifford.
17. None of the references teach computing projected prices of automobiles. Official Notice is taken (MPEP § 2144.03) that this limitation is common, and has obvious value to automobile buyers. The NADA blue book has been available on disc or CD for many years, and the Consumers Union has also offered an on-line auto price service for many years. It would therefore have been obvious to one of ordinary skill in the art, at the time of the invention, to add this limitation.
18. Claim 31 is rejected under 35 USC 103(a) as obvious over the references cited in para. 2 above and further in view of Chapin, Jr.
19. Neither Bull et al. nor Gifford teaches using automobile mileage to estimate maintenance schedules. Chapin, Jr. teaches (col. 2 lines 49-52) using automobile mileage to estimate

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maintenance schedules. Because Bull et al. and Gifford teach features that would enhance the simple system of Chapin, Jr., it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Bull et al. and Gifford to those of Chapin, Jr. These enhanced features include a global reach for data over the Internet while still maintaining the advantages of local processing.

### ***Conclusion***

20. This is a continuation of applicant's earlier Application No. 09295864. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
21. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
23. The examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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24. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
25. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that “disposal or clarification for appeal may be accomplished with only nominal further consideration” (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.
26. Applicant may have after final arguments considered and amendments entered by filing an RCE.
27. **ABANDONMENT** – If examiner cannot by telephone verify applicant’s intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office’s web site, [www.uspto.gov](http://www.uspto.gov). At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

**DONALD L. CHAMPAGNE**  
**PRIMARY EXAMINER**

Donald L. Champagne  
Primary Examiner  
Art Unit 3622

22 July 2005